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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/633,575 | 08/05/2003 | Trent West | 81876-4095 | 5437 |
| 28765 | 7590 | 10/04/2005 | EXAMINER | |
| WINSTON & STRAWN LLP 1700 K STREET, N.W. WASHINGTON, DC 20006 | | | MILLER, WILLIAM L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3677 | |

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|-----------------------------|--|
| Office Action Summary | Application No. 10/633,575 | Applicant(s) WEST, TRENT | |
| | Examiner William L. Miller | Art Unit 3677 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 19,20 and 23-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18,21,22 and 28-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>04252005</u> | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, Figs. 2-5 and 7-11, in the reply filed on 07-15-2005 is acknowledged. It is noted the applicant failed to present specific arguments regarding any of the previously identified species being obvious variants of one another. The applicant has indicated claims 1-38 read on the elected species. The examiner disagrees as claims 19-20 recite a coating not present in the elected species, and claims 23-27 recite a unitary annular ring, namely the non-elected species of Group V, Fig. 15. Consequently, claims 19-20 and 23-27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

2. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Regarding claim 22, it is unclear which "surface" is being referenced.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1-18, 21, 22, and 28-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grossman (US#1431652) in view of Lederrey (US#3242664).

6. Grossman discloses a jewelry article comprising an annular finger ring 1 having an inner surface (inner circumference) and external surface (outer circumference) wherein each surface has a continuous portion concentric around the circumference of the ring, the portions being parallel. The ring is polished and buffed for a desired finish and luster (page 1, lines 105-109). The ring includes a cavity (continuous slot) 3 which receives an insert 2, namely a precious metal, via a mechanical fit. The final shape of the ring provides design details which are maintained indefinitely. Alternatively, element 2 can represent an additional external surface (claim 9).

7. Regarding claims 1, 2, and 13, Grossman discloses the ring is a metal as opposed to a hard material comprising a sintered tungsten carbide material and a binder component such that ring has a grey mirror finish with the hard material being virtually indestructible during normal use. However, the applicant is reminded the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). In any event, Lederrey discloses a jewelry article comprising a body 1 made of a hard material consisting essentially of a sintered tungsten carbide material and a metal (cobalt) binder (col. 1, lines 65-70), such that the article has a polished grey mirror finish with the hard material being long wearing and virtually indestructible during normal use of the jewelry (see col. 5, lines 33-56). Therefore, as taught by Lederrey, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Grossman by utilizing a hard material which consisted essentially of a sintered tungsten

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carbide material and a metal (cobalt) binder, such that the article had a polished grey mirror finish with the hard material being long wearing and virtually indestructible during normal use of the jewelry.

8. Regarding claims 7 and 21, Lederrey teaches the hard material is a sintered tungsten carbide and does not recite any additional materials, other than the metal binder, included in the hard material. Therefore, although Grossman (as modified by Lederrry) fails to specifically disclose the hard material contains at least 85 weight% tungsten carbide with a density of at least 13.3g/cm³, it would have been obvious design choice to utilize 85 weight% tungsten carbide with a density of 13.3 g/cm³ as the optimization of proportions in a prior art device is a design consideration within the skill of the art. In re Reese, 290 F.2d 839, 129 USPQ 402 (CCPA 1961).

9. Regarding claims 2, 3, 5, 6, 30, 33, 34, and 37, although Grossman fails to disclose the specific shape/design of the external surface (outer circumference) and/or the inner surface (inner circumference) of the ring, it would have been an obvious design choice to utilize the claimed shape/design as a change in ornamental design having no mechanical function is an aesthetic design consideration within the skill of the art. In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

10. Claims 1-18, 21, 22, and 28-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bager (US#2050253) in view of Lederrey (US#3242664).

11. Bager discloses a jewelry article comprising an annular finger ring 1 having an inner surface (inner circumference) and external surface (outer circumference) wherein each surface

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has a continuous portion concentric around the circumference of the ring, the portions being parallel. The ring includes a cavity (continuous slot) 7 which receives an insert 9, namely a precious metal, via a mechanical fit. The final shape of the ring provides design details which are maintained indefinitely. Alternatively, element 9 can represent an additional external surface (claim 9).

12. Regarding claims 1, 2, and 13, Bager discloses the ring is a metal as opposed to a hard material comprising a sintered tungsten carbide material and a binder component such that ring has a grey mirror finish with the hard material being virtually indestructible during normal use. However, the applicant is reminded the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). In any event, Lederrey discloses a jewelry article comprising a body 1 made of a hard material consisting essentially of a sintered tungsten carbide material and a metal (cobalt) binder (col. 1, lines 65-70), such that the article has a polished grey mirror finish with the hard material being long wearing and virtually indestructible during normal use of the jewelry (see col. 5, lines 33-56). Therefore, as taught by Lederrey, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bager by utilizing a hard material which consisted essentially of a sintered tungsten carbide material and a metal (cobalt) binder, such that the article had a polished grey mirror finish with the hard material being long wearing and virtually indestructible during normal use of the jewelry.

13. Regarding claims 7 and 21, Lederrey teaches the hard material is a sintered tungsten carbide and does not recite any additional materials, other than the metal binder, included in the hard material. Therefore, although Bager (as modified by Lederry) fails to specifically disclose

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the hard material contains at least 85 weight% tungsten carbide with a density of at least 13.3g/cm³, it would have been obvious design choice to utilize 85 weight% tungsten carbide with a density of 13.3 g/cm³ as the optimization of proportions in a prior art device is a design consideration within the skill of the art. In re Reese, 290 F.2d 839, 129 USPQ 402 (CCPA 1961).

14. Regarding claims 2, 3, 5, 6, 30, 33, 34, and 37, although Bager fails to disclose the specific shape/design of the external surface (outer circumference) and/or the inner surface (inner circumference) of the ring, it would have been an obvious design choice to utilize the claimed shape/design as a change in ornamental design having no mechanical function is an aesthetic design consideration within the skill of the art. In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

Response to Arguments

15. Applicant's arguments filed 04-25-2005 have been considered but are moot in view of the new ground(s) of rejection.

16. The declaration of Trent West filed 04-25-2005 fails to effectively establish commercial success as the provided sale figures have not been adequately defined. Moreover, evidence which addresses the number of sales, without providing market share information, is insufficient to establish commercial success. In re Baxter Travenol Labs, 952 F.2d 388, 21 USPQ2d 1281 (Fed. Cir. 1991). Gross sales figures do not show commercial success absent evidence as to market share, Cable Electric Products, Inc. v. Genmark, Inc., 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985), or as to the time period during which the product was sold, or as to what sales

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would normally be expected in the market, Ex parte Standish, 10 USPQ2d 1454 (Bd. Pat. App. & Inter. 1988).

Conclusion

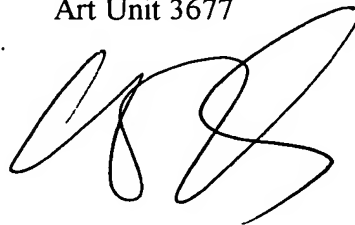
Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Miller whose telephone number is (571) 272-7068.

The examiner can normally be reached on Tuesday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on (571) 272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

William L. Miller
Primary Examiner
Art Unit 3677



WLM